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Applicant: TODA et al.	Atty. Dkt.: 11-224
Serial No.: 10/776,196	Art Unit: 3611
Filed: February 12, 2004	Examiner: Anne Marie M BOEHLER
Title: CONTROL UNIT FOR ELECTRIC POWER STEERING	Confirmation No.: 2752

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In view of the Advisory Action mailed on October 13, 2006 and the Notice of Appeal filed concurrently herewith, please consider the following remarks.

- I. The Examiner's 103(a) rejection of claims 1-7 based on United States Patent Nos. 6,902,028 ("Takatsuka") and 4,800,974 ("Wand") does not disclose or suggest every recited claim limitation.

MPEP 2143 states that "[t]o establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." This is clearly not the case with the rejection based on Takatsuka and Wand.

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The Examiner asserts that in Wand, the “temperature detecting means” recited in claim 1 is shown by the disclosed temperature-sensing device 570, and “motor current detecting means” recited in claim 1 is shown by the disclosed amplifier 586. The Examiner also asserts that the fact that the temperature-sensing device 570 and the amplifier 586 are both identified as being within the same duty cycle fold-back circuit 264, provides the required suggestion that “said motor current detecting means is integrated in an integrated circuit package, and said temperature detecting means is integrated in said integrated circuit package so as to be situated in the vicinity of said amplifier of said motor current detecting means,” as recited in claim 1. (See Office Action dated May 19, 2005, page 2, and Advisory Action dated October 13, 2006, page 2.)

However, nothing in Wand discloses or suggests that either the temperature-sensing device 570 serve to detect the temperature of the amplifier 586, or that the temperature-sensing device 570 and the amplifier 586 be integrated in the same integrated circuit package, so that the temperature-sensing device 570 is situated in the vicinity of the amplifier 586.

First, the temperature-sensing device 570 in Wand serves to detect the temperature of a plurality of FETs 502, 504, 506, and 508, *not* the temperature of the amplifier 586. (See Applicants’ response dated September 19, 2006, pages 3 and 4.) And there is no disclosure or suggestion in Wand that the amplifier 586 should be connected to or otherwise operated at the same temperature as the FETs 502, 504, 506, and 508. As a result, Wand does not disclose that the temperature-sensing device 570 operate to detect a temperature of the amplifier 586.

Second, Wand discloses that the temperature-sensing device 570 is connected to a common heat sink attached to elements in the drive circuit 260, *not* the duty cycle fold-back circuit 264. There is no disclosure in Wand that the temperature-sensing device 570 be integrated to any element in the in duty cycle fold-back circuit 264, or that the elements in the duty cycle

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fold-back circuit 264 be integrated in the same integrated circuit package. The fact that the temperature-sensing device 570 and the amplifier 586 are located in the same functional circuit grouping does not necessarily imply that they are physically close. (See Applicants' response dated September 19, 2006, pages 3 and 4.)

II. The Examiner has not provided any proper suggestion or motivation to modify Takatsuka or Wand.

The Examiner has also failed to provide any proper suggestion or motivation to modify Takatsuka or Wand as set forth in her rejection 103(a) rejection to obtain her cited combination. MPEP 2143 states that "[t]o establish a *prima facie* case of obviousness ... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings," and that "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). (See also MPEP 2143.01.)

The Examiner asserts that "it would have been clear to a skilled artisan that the circuit elements [described in Wand] should be in close proximity to each other, particularly since the temperature sensor is designed to monitor elements of the circuit. (See Office Action dated May 19, 2005, page 3, and Advisory Action dated October 13, 2006, page 2.)

But Wand specifically discloses a temperature-sensing device 570 that is proximate to and detects the temperature of a plurality of FETs 502, 504, 506, and 508, *not* the amplifier 586. (See Applicants' response dated September 19, 2006, pages 3 and 4.) It is Applicants' specification that discloses that a temperature detecting circuit 15 be located in the vicinity of the motor current detecting circuit 14 to monitor the temperature of the current detecting circuit 14.

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(See Applicants' specification, page 8, lines 1-22, and FIG. 1.) The Examiner's suggestion to modify the disclosure of Wand to meet the limitations of Applicants' claim 1 therefore come from Applicants' own disclosure, not the prior art, and is therefore impermissible.

MPEP 2143.01 further notes that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). It is therefore not sufficient that the teachings of Wand and Takanaka *could* be combined. There must be some actual suggestion.

The Examiner's statement that it would have been clear to a skilled artisan that the circuit elements should be in close proximity to each other, particularly since the temperature sensor is designed to monitor elements of the circuit is tantamount to a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made." This is specifically disallowed by MPEP 2143.01, which requires some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). The Examiner has provided no such adequate reason.

III. The Examiner has not provided a *prima facie* case of obviousness with respect to claims 1-7 over Takatsuka and Wand

The Examiner has failed to meet the requirements of a *prima facie* case of obviousness. First, she has not provided references that disclose or suggest all of the recited features of the claims; second she has not provided any proper suggestion or motivation to modify the cited references to disclose all of the recited features of the claims.

Therefore, in view of the above remarks, the combination of Takatsuka nor Wand does not disclose or suggest all of: "a motor current detecting means," "a temperature detecting means

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for detecting a temperature of said motor current detecting means,” and that “said motor current detecting means is integrated in an integrated circuit package, and said temperature detecting means is integrated in said integrated circuit package so as to be situated in the vicinity of said amplifier of said motor current detecting means,” as recited in claims 1-7. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness under 35 USC 103(a).

In view of the foregoing, Applicant respectfully requests that the Examiner’s final rejection be withdrawn and the application allowed. Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,



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